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No. 71-1462

In the

Supreme Court of the United States

OCTOBER TERM, 1971

SOLO CUP COMPANY,

Petitioner,

v.

ILLINOIS TOOL WORKS, INC.,

Respondent.

MOTION OF SWEETHEART PLASTICS, INC. FOR LEAVE TO FILE BRIEF AMICUS CURIAE WITH BRIEF ANNEXED

DUGALD S. McDOUGALL
135 South LaSalle Street
Chicago, Illinois 60603
Tel.: 312-346-0338

GEORGE L. GREENFIELD
185 Devonshire Street
Boston, Massachusetts 02110
Tel.: 617-426-6131
Attorneys for Sweetheart
Plastics, Inc.
Amicus Curiae

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Sweetheart Plastics, Inc., a manufacturer of nestable plastic cups and licensee under respondent's patent in suit No. 3,091,360, respectfully moves for leave to file the annexed brief amicus curiae in support of the petition of Solo Cup Company for a writ of certiorari in this case.

Sweetheart Plastics, Inc. believes the '360 patent to be invalid; should it be so adjudged, Sweetheart and the other licensees would be relieved of further obligation to pay royalties to respondent (*Lear, Inc.* v. *Adkins* (1969),

395 U.S. 653). Hence Sweetheart, for itself and all other companies in like position, has a vital interest in supporting Solo Cup Company's petition.

In the annexed brief, we present for the Court's consideration two points, not argued in petitioner's brief, which weigh markedly in favor of issuance of the writ. For that reason, and because the issue here is important indeed, we urge the Court to receive and consider this brief.

Advance consent to the filing of this brief amicus curiae having been refused by respondent Illinois Tool Works, Inc., the Court is earnestly requested to grant this motion for leave to file.

Respectfully submitted,

DUGALD S. MCDOUGALL
135 South LaSalle Street
Chicago, Illinois 60603
Tel.: 312-346-0338

GEORGE L. GREENFIELD
185 Devonshire Street
Boston, Massachusetts 02110
Tel.: 617-426-6131
Attorneys for Sweetheart Plastics, Inc. Amicus Curiae

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BRIEF AMICUS CURIAE OF SWEETHEART PLASTICS, INC.

Sweetheart Plastics, Inc., amicus curiae, by leave of Court, submits this brief in support of the petition of Solo Cup Company for issuance of a writ of certiorari.

The interest of the amicus curiae in the controversy at hand arises from the fact that it is a manufacturer of nestable plastic cups of the type against which respondent ITW asserts the monopoly of its '360 patent. Solely as the result of prior litigation, it is an unwilling licensee under the patent and is paying royalties to respondent.

As the District Court hinted (Pet. Appx. A-8), the question whether respondent's patent is valid almost certainly turns on the meaning of Section 102(a) of the Patent Act.

The Court of Appeals, we firmly believe, interpreted that statute wrongly and, in so doing, saddled an unlawful monopoly on the whole plastic-cup industry—not just on the petitioner.

We shall not impose on the time of a busy Court by re-arguing matters already dealt with in the opinion of the District Court and the petitioner's brief; the mission of this brief, rather, will be to present two additional points, favoring issuance of the writ, which warrant the Court's attention.

I. The Error In The Court Of Appeals' Rewriting Of Section 102(a) Is Plain When That Section Is Read In Conjunction With Its Companion Section 102(g).

Section 102 of the Patent Act, in its several subsections, catalogs a series of "statutory bars"—i.e., the various conditions under which no patent may be granted. And Section 103, in providing that a patent may not be granted if its subject matter was obvious in view of the prior art, uses the expression "prior art" as a shorthand term meaning "what was known before as described in Section 102" (H.R. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); *Hazeltine Research, Inc.* v. *Brenner* (1965), 382 U.S. 252, 254).

In the present case, the issue is the extent to which the term "prior art" in Section 103 includes subject matter admittedly "known or used by others in this country" prior to the applicant's conception of the "invention" on which he seeks a patent. If that subject matter which was "known or used by others in this country" came initially from a third person, then all hands agree that it *is* "prior art"

against which the patentability of an applicant's invention is to be judged. The parties part company, however, in the case where the subject matter thus publicly "known or used" was something developed and made public by the applicant himself before he conceived the improvement to which his application relates.

The petitioner contends—and the District Court held—that it makes no difference whether the previously "known or used" subject matter came originally from an outsider or from the applicant; it is prior art, either way. Respondent, however, insists that subject matter thus publicly "known or used", while prior art against everyone else, is *not* prior art against the person who invented it.

The Court of Appeals ruled for respondent (Pet. Appx. A-19), holding that to be prior art the earlier subject matter "must have been 'invented by others' as well as 'known or used by others'."

Section 102(a), in short, has been rewritten by the Court of Appeals to read thus (judicially added words italicized):

> "A person shall be entitled to a patent unless—
> "(a) the invention was *invented by others, and* known or used by others in this country . . . before the invention thereof by the applicant for patent . . ."

In amending Section 102(a) in that fashion, the Court of Appeals overlooked the fact that the Congress, in Section 102(g) of the very same law, has dealt separately—and explicitly—with those cases in which relevant subject matter was "invented by others" in this country before the applicant made *his* invention.

The first sentence of Section 102(g) reads:

> "A person shall be entitled to a patent unless—
> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it."

Note—and this is important—that when subject matter on which a patent is sought was previously *invented by others* in this country, it is prior art under Section 102(g) *whether or not* it was "known or used by others".

Thus, when the Court of Appeals wrote the words "invented by others" into Section 102(a), it emasculated the "known or used by others in this country" provision by restricting its application to cases *already covered* by Section 102(g)!

Plainly, Congress never intended anything of the kind. Congress meant, by Section 102(a), precisely what its words say—namely, that an "invention" shall be judged for patentability in the light of all knowledge accessible to the public in this country at the time it was made, whether such knowledge sprang from the brains of outsiders or from prior work of the same "inventor".

II. This Record, Interlocutory Though It Be, Affords An Ideal Setting For Consideration By This Court Of The Important Issue Presented.

This Court's reluctance to review interlocutory orders is well known. In this case, however, the Court should depart from its custom and grant the writ because:

(a) The issue is solely one of statutory construction, presented on a short record with agreed facts.

(b) Thanks to the District Court's insight in recognizing the pivotal nature of this one issue and hence allowing an interlocutory appeal, the case has come to this

Court in a refreshingly pure form, almost as if the Court of Appeals had certified the question under 28 U.S. Code, §1254(3).

(c) Postponing resolution of the issue until after final judgment will prolong for years the thralldom in which the respondent now holds the plastic-cup industry.

(d) Unless reversed now, the erroneous decision of the Court of Appeals will do great harm by leading other courts astray.

CONCLUSION

When a Court of Appeals amends an important law by reading into it words which the Congress did not put there, frustrating the plain meaning of the words Congress did select, that alone is reason enough for this Court to act.

The writ should issue.

Respectfully submitted,

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Chicago, Illinois 60603
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185 Devonshire Street
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